

## REMARKS

Applicants sincerely appreciate the Examiner granting an Interview and speaking with Applicants on 3/10/08. Applicants also sincerely appreciate the clarifications made by Examiner concerning the creation of an "image" in paragraph 0054 and 0115 in Goeller, as well as the general comments for the image of Drummond.

Claims 1-29 are pending and stand rejected. The drawings are all accepted. Claims 1-8, 17-22, and 23-29 stand rejected under 35 USC § 103(a) as being unpatentable over Goeller et al. U.S. Pat. App. Pub. 2002/0178112 A1 (hereinafter "Goeller") in view of Drummond et al. U.S. Pat. App. Pub. 2003/0217005 A1 (hereinafter "Drummond").

Claims 9-16 stand rejected under 35 USC § 102(b) as being anticipated by Goeller. Applicants respectfully maintain that the anticipation and obviousness rejections with respect to the claims are traversed in light of the amendments and the following remarks:

### Claim rejections under 35 USC § 103(a)

The Office action rejected claims 1, 2-8 under 35 USC § 103(a) as being unpatentable over Goeller. The key to supporting any rejection under 35 USC § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.<sup>1</sup> Additionally, all words in a claim must be considered in judging the patentability of that claim against the prior art.<sup>2</sup>

Goeller generally describes how a point-of-sale (POS) Check Service may convert a paper check into an electronic funds transaction (Goeller abstract; see also [0012]). The Office Action states "... Goeller discloses a method for generating an e-check, the method comprising: scanning a check to create an image of the check in response to receiving a check as payment for a transaction (see fig.5, also see paras 0054 and 0115, with emphasis added); ...". However, contrary to this assertion, Applicants respectfully point out that the referenced figure and paragraphs do not create an image of the check. Instead, paragraph 0054 starts describing the different elements of the flowchart in figure 5 and how an embodiment may convert a check into an electronic transaction. More specifically, paragraph 0054 describes how a clerk may enter the amount of the transaction, with one way entering the amount: "using scanning or other known

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<sup>1</sup> Manual of Patent Examining Procedure §2142; *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007).

techniques.” (lines 5-9 of [0054]). Subsequently, paragraph 0055 goes on to describe how the check may be “swiped” to obtain the MICR information (lines 1-5 of [0055]; see also element 310 of figure 5). Paragraph 0115 of Goeller reiterates how check information, such as the amount of the transaction and the MICR information may be entered automatically, such as with OCR (optical character recognition) equipment ([0115]). Applicants respectfully point out that paragraph 0115 does not disclose or suggest creating an image of a check.

Contrasted with Goeller, embodiments of Applicants create a negotiable instrument which comprises a “check object” (or “e-check”) which **includes an image of the check** and binary data of the check information (see [0016]). Having an e-check based on the binary data and the check image may allow a merchant to **substitute the e-check** for the paper check as the **negotiable instrument** (see [0017]). For example, one embodiment described by Applicants may create a J-PEG image of the check ([0024]). Such an image differs considerably from “scanning” a check to obtain the amount, or “swiping” the check to read the MICR information.

The Office Action goes on to state that:

“Goeller implicitly discloses, though not explicitly, **generating a check object based upon the image**, the amount and the check information (see Goeller paras 0054). However, a secondary reference, Drummond, explicitly discloses generating a check object based upon the image, the amount, and the check information (see Drummond paras 0262). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Goeller and Drummond to speed up check processing at the POS.”

However, Applicants respectfully point out that referenced section of Drummond does not disclose generating a negotiable instrument that comprises a check object which is based upon the image, especially generating the check object for the purpose of the object with the image taking the place of the check as the negotiable instrument.

In general, Drummond describes “A system and method of providing an electronic transaction receipt from a cash dispensing ATM.” (see Drummond abstract, emphasis added). The abstract of Drummond goes on to point out that “[t]he receipt may include an image or images associated with the transaction” and that images of checks may examples of such images

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<sup>2</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

associated with the transaction (see Drummond abstract). That is to say, Drummond creates an image to document the transaction, which may be a deposit into the ATM.

Contrastingly, Applicants respectfully argue that paragraph 0262 does not disclose generating a negotiable instrument which comprises a check object in the manner that “check object” is interpreted and used in the specification. Instead, paragraph 0262 describes how an ATM may generate an image of a received check and how copies of the image may be sent to people and/or entities associated with the transaction ([0262]). The image for the “receipt” may include video, such as video taken from a security camera at the ATM ([0262], see also [0255]). Drummond goes on to describe how the check image can be sent to the owner of the checking account, such as by an electronic message in an e-mail. In other words, Applicants respectfully argue that Drummond creates an image of the check to serve as a **receipt for a transaction**.

As just described, Drummond does not create an image for a check object, wherein the check object is **to replace the check** and serve as a **negotiable instrument**. To clarify this distinction, Applicants have amended claim 1 to include the limitation “generating a negotiable instrument, wherein the negotiable instrument comprises a check object based upon the image, the amount, and the check information, wherein further the check object includes the image.” The amendment does not add new matter and support for the claim can clearly be found in the specification (see [0017], [0022-0024], and [0035]).

In light of the above discussion and amendment to claim 1, Applicants respectfully argue that neither Goeller nor the combination of Goeller and Drummond disclose all of the elements of claim 1. Further, Applicants respectfully submit that the Office Action has not clearly articulated any reasons why creating an image of a check for the purpose of replacing the check with an e-check as a negotiable instrument would have been obvious from the combination of Goeller and Drummond. Accordingly, Applicants respectfully traverse rejections of obviousness in regard to independent claim 1, especially as amended, and request that claim 1 be allowed.

In regard to claims 2-8, claims 2-8 depend from independent claim 1. If an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is nonobvious.<sup>3</sup> As noted above, Applicants respectfully maintain that independent claim 1 is not obvious and that the rejection is traversed. Because the rejections of claims 2-8 are predicated upon the obviousness of claim 1, Applicants respectfully traverse the rejections of dependent claims 2-8 and request that the claims be allowed.

In regard to independent claim 17, the Office Action states that Goeller has an image scanner to create an image of a check and refers to fig.5, paragraph 0054, and paragraph 0115. The Office Action continues by adding that Drummond explicitly discloses an e-check generator to generate a check object based on the image and refers again to paragraph 0262. However, as noted in the above discussion, Applicants respectfully maintain that neither Goeller nor the combination of Goeller and Drummond disclose or suggest using an image scanner to create an image for a negotiable instrument that comprises a check object. To clarify this distinction, Applicants have amended independent claim 17 to include the limitation “an e-check generator to generate negotiable instrument, wherein the negotiable instrument comprises a check object based upon the image, the amount, and the check information, wherein further the check object includes the image.” Again, this amendment does not add new matter and support for the claim can clearly be found in the specification (see [0017], [0022-0024], and [0035]). Accordingly, Applicants respectfully traverse rejections of obviousness in regard to amended independent claim 17 and request that claim 17 be allowed.

In regard to claims 18-22, claims 18-22 depend from independent claim 17. As noted above, Applicants respectfully maintain that independent claim 17 is not obvious and that the rejection is traversed. Because the rejections of claims 18-22 are predicated upon the obviousness of claim 17, Applicants respectfully traverse the rejections of dependent claims 18-22 and request that the claims be allowed.

In regard to independent claim 23, the Office Action states that Goeller has a machine-accessible medium containing instructions for scanning a check to create an image of the check and refers to fig.5, paragraph 0054, and paragraph 0115. The Office Action continues by adding that Drummond explicitly discloses generating a check object based on the image and refers again to paragraph 0262. However, as noted in the above discussion, Applicants respectfully maintain that neither Goeller nor the combination of Goeller and Drummond disclose or suggest scanning a check to create an image and generating a negotiable instrument that comprises a check object to replace the check. To clarify this distinction, Applicants have amended independent claim 23 to include the limitation “generating negotiable instrument, wherein the negotiable instrument comprises a check object based upon the image, the amount, and the check information, wherein further the check object includes the image.” Again, this amendment does not add new matter and support for the claim can clearly be found in the specification (see

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<sup>3</sup> *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

[0017], [0022-0024], and [0035]). Accordingly, Applicants respectfully traverse rejections of obviousness in regard to amended independent claim 23 and request that claim 23 be allowed.

In regard to claims 24-29, claims 24-29 depend from independent claim 23. As noted above, Applicants respectfully maintain that independent claim 23 is not obvious and that the rejection is traversed. Because the rejections of claims 24-29 are predicated upon the obviousness of claim 23, Applicants respectfully traverse the rejections of dependent claims 24-29 and request that the claims be allowed.

#### Claim rejections under 35 USC § 102(b)

The Office action rejected claims 9-16 under 35 USC § 102(b) as being anticipated by Goeller. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>4</sup> Additionally, the identical invention must be shown in as complete detail as is contained in the ... claim.<sup>5</sup>

The Office Action states that “Goeller discloses a method for transacting with an e-check, the method comprising: generating the e-check based upon a check”. However, as noted in the above discussion, Applicants respectfully maintain that Goeller does not disclose generating an e-check based upon an image of the check, wherein the e-check **includes** the image. To clarify this distinction, Applicants have amended independent claim 9 to include the limitation “generating the e-check based upon an image of a check, to substitute for a check as payment for a transaction, wherein the e-check includes the image”. Again, this amendment does not add new matter and support for the claim can clearly be found in the specification (see: [0016], [0017], [0022-0024], and [0035]). Therefore, Applicants respectfully submit that Goeller does not anticipate amended claim 9. Consequently, Applicants respectfully traverse the rejection of independent claim 9 and request that claim 9 be allowed.

Regarding claims 10-16, claims 10-16 depend from independent claim 9. As amended and noted above, independent claim 9 is in condition for allowance. Therefore, Applicants respectfully submit that the rejections to dependent claims 10-16 are now moot. Accordingly, Applicants respectfully traverse the rejections of claims 10-16 and request that the claims be allowed.

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<sup>4</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

## CONCLUSION

Applicants have amended independent claims 1, 9, 17, and 23. Applicants respectfully traversed the cited references in regard to the claim rejections under 35 USC § 102(b) and 35 USC § 103(a). Accordingly, Applicants believe that this response constitutes a complete response to each of the issues raised in the Office Action. In light of the remarks accompanying the amended claims, Applicants believe that the pending claims are in condition for allowance. Thus, Applicants request that the rejections be withdrawn, the pending claims be allowed, and that the application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (512) 391-4913.

A request for an extension as well as authorization for the corresponding fee accompany this response. No other fees are believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 50-0563 for any such required fee.

Respectfully submitted,

March 10, 2008

/Jeffrey S Schubert/

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Date

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